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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/095,365	06/10/98	KAKINUMA	1600520115000

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IM22/0923

EXAMINER
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GRAY, L

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 09/23/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/095,365

Applicant(s)

Kakinuma et al.

Examiner

Gray, Linda L.

Group Art Unit

1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 6-10-98, 9-30-98, & 7-7-98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-3 and 7-13 is/are rejected.
- ☒ Claim(s) 3-6 and 13 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

## **DETAILED ACTION**

### **Specification**

1. Applicants are reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because of the following: **(a)** "is disclosed" (L 2) and **(b)** "comprise" (L 6), MPEP § 608.01(b). Correction is required.
3. The disclosure is objected to because of the following informality: the Brief Description of the Drawings does not make reference to Figures 7A, 7B, and 7C. Appropriate correction is required.

### **Claim Objections**

4. **Claims 3 and 13 are objected to because of the following informalities:** **(a)** --said-- should be inserted after "each" (clm 3, L 5), **(b)** --said-- should be inserted after "of" (clm 3, L 6), and **(c)** --the-- should be inserted after "receiving" (L 2). Appropriate correction is required.
5. **Claims 4-6 are objected to under 37 CFR 1.75(c) as being in improper form** because a multiple dependent claim cannot depend from a multiple dependent claim, MPEP § 608.01(n). Accordingly, claim 4-6 not been further treated on the merits.

### **Declaration**

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required, MPEP §§ 602.01 and 602.02. The oath or declaration is defective because the filing date of priority document 9-251485 is incorrect.

**Claim Rejections - 35 USC § 112**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-3, 7-10, and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.**

**Claim 1**, "the end" (L 5) renders claim 1 indefinite because there is insufficient antecedent basis for this limitation. **Claim 12** is indefinite because does not clearly indicate if the apparatus pieces recited belong to the image processing apparatus or to the sheet sorting apparatus.

**Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-2 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark, Jr. et al. (US 4,966,644).**

**Claims 1 and 11**, Clark, Jr. et al. (Clark et al.) teach a sheet sorting apparatus for adhering marker 3 to predetermined sheet 4 including **(a)** tape feeder 38 for pulling out tape 13 having heat/pressure sensitive adhesive 15 on one side edge 17, **(b)** cutter 39 for making marker 3 by cutting an end of tape 13, **(c)** guide 35 for positioning marker 3 to a predetermined position on sheet 4, and **(d)** marker-and-sheet-feeder 41 for feeding marker 3 and sheet 4 in partially overlapping position wherein marker 3 is adhered to sheet 4 by a predetermined pressure force (caused by rollers 108/109) as they pass through feeder 41 (p 4, L 34, to p 12, L 37). The claim limitation of "being output by an image processing apparatus" (L 2) is an intended use of the sheet sorting apparatus (i.e., use the sheet sorting apparatus with an image processing apparatus). There is nothing in the claims that requires the sheet sorting

apparatus to be used with an imaging processing apparatus. **Claim 2**, marker 3 is adhered to a lower side of sheet 4 in that edge 17 is on the lower side of sheet 4.

**Claim Rejections - 35 USC § 103**

**11.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12.** This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

**13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, Jr. et al.**

**Claims 7-8**, the difference between claim 7 and Clark et al. is that Clark et al. do not teach a single motor for driving feeder 38, cutter 39, guide 35, and feeder 41 but teaches separate external motors.

It is convention to use one motor to operate several items of an apparatus in order to save on the cost of purchasing more than one motor, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Clark et al. a single motor for driving feeder 38, cutter 39, guide 35, and feeder 41 instead of separate motors in order to save on the cost of purchasing more than one motor.

**Allowable Subject Matter**

**14. Claims 3 and 9-10 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.**

**15. Claims 12-13 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.**

**16.** The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for the indication of allowable subject matter in **claim 3** is that the prior art of record does not teach a character mark printer for applying a predetermined color pattern or character to marker 3 and a printer controller for determining the character or pattern to print on marker 3 so that the same character or pattern is printed on each marker 3 in a group of sheets 4.

The primary reason for the indication of allowable subject matter in **claim 12** is that the prior art of record does not teach an image processing apparatus including a sheet sorting apparatus for adhering a marker to a predetermined sheet discharged from the image processing apparatus where the sheet sorting apparatus includes a tape feeder for pulling out a tape having a pressure sensitive adhesive on one side edge, a guide for positioning the marker to a predetermined position on the sheet, and a marker and sheet feeder for feeding the marker and sheet in a partially overlapping positioning wherein the marker is adhered to the sheet by a predetermined pressure force as they pass through the marker and sheet feeder.

**17.** Since allowable subject matter has been indicated, Applicants are encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

**18.** As allowable subject matter has been indicated, Applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with, 37 CFR 1.111(b) and MPEP § 707.07(a).

### **Conclusion**

**19.** Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703)308-1093, Monday-Friday from 8:00 am to 4:30 pm. The necessary fax numbers are (703)305-7718 (official), (703)305-7115 (unofficial), and (703)305-3599 (after final).

llg  
September 22, 1999

*Linda L. Gray*  
Linda L. Gray  
Patent Examiner  
Art Unit 1734